

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ADRIAN J. TURNER, SIMON PEARCE,
DAVID ANTHONY EVES and ALLAN ROGER TIMMS

Appeal No. 2002-2040
Application No. 09/160,490

ON BRIEF

Before McKELVEY, *Senior Administrative Patent Judge* and MEDLEY,
and MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 5-9, which are all the pending claims of this application.

REPRESENTATIVE CLAIM

The appellant has indicated (Brief, page 3) that, for the purposes of this appeal, claims 5-9 will stand or fall together. Accordingly, we select claims 5 and 9, the independent claims, to be representative of the claims on appeal. Note 37 CFR §1.192(c)(7). See also In re Dance, 160 F.3d 1339, 1340 n.2, 48

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USPQ2d 1635, 1636 n.2 (Fed. Cir. 1998); In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Claims 5 and 9 are reproduced in full below:

5. A method of enabling customizing technical features of network-enabled equipment of an end-user, said method comprising:
storing a profile of the end-user's preferences in regard to technical features of said equipment;
storing information describing prospective new and modified technical features of said equipment;
determining if a prospective technical feature is relevant to the end-user, based on the stored information concerning said feature and the user-profile; and
notifying the end-user via the network of the availability of an option to select a relevant prospective technical feature for addition to the equipment.

9. A method of customizing an end-user's network-enabled equipment, said method comprising:
registering in a registration server a profile of the user's preferences in regard to technical features of said equipment, said profile being based on information provided by the user and by suppliers of said equipment;
storing said profile of the user's preferences in a user profile database;
assembling and storing in a feature database information relating to availability of prospective new and modified technical features of said equipment; and
associating, in a feature management server, the user's preferences as determined from the user profile database and the feature information as determined from the feature database, so as to determine and supply the user with feature information which is consistent with the user's preferences.

The References

In rejecting the claims under 35 U.S.C. §102(b) and 35 U.S.C. §103(a), the examiner relies upon the following references:

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Rowley	5,999,740	Dec. 07, 1999
Traversat et al. (Traversat)	6,161,125	Dec. 12, 2000

The Rejections

Claims 5-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rowley in view of Traversat.

The Invention

The invention relates to providing customized technical functions to a network-enabled piece of equipment of an end user. A profile of the end-user and information about a technical feature for use with the equipment are stored in a server system. (Specification, page 2, lines 21-24). Based upon the user profile it is determined whether the user should be notified about the availability of this feature. If the user is notified, and the feature is software, the feature may be downloaded from the network. If the feature is hardware, it may be shipped to the end user (Id., page 2, lines 25-29). Further details of the claimed method are seen with reference to claims 5 and 9 above.

The Rejection of Claims 5-9 Under 35 U.S.C. §103(a)

Claims 5-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rowley in view of Traversat.

The examiner has found that Rowley describes a method of enabling customizing technical features of network-enabled equipment of an end user, including storing a profile of the end

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user's preferences in regard to the technical features of the equipment, storing information relating to new and modified technical features of the equipment, determining if a prospective technical feature is relevant to the end user, based upon the stored information, and notifying the end-user of the option to select a relevant technical feature for addition to the equipment (Examiner's Answer, Paper 22 page 3, lines 6-17). The examiner has additionally found that Traversat describes a server to send application updates over a network to a client for the client to determine which application to upgrade (Id., page 3, line 19 - page 4, line 2).

The examiner then concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate notifying the client via a network, taught by Traversat, into the updating system, taught by Rowley, since Traversat suggests that the configuration and profile files of a client, similar to the registration file disclosed by Rowley, can be on the server, so that the client would be notified of upgrades over the network. According to the examiner, one of ordinary skill in the art would have been motivated to modify Rowley to include the network server in view of Traversat, so that the configuration and profile files would be centrally stored to easily determine upgrades by multiple clients to be able to have a

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mass push of upgrades. (Id., page 4, lines 2-9).

The appellant, on the other hand, draws several distinctions between the cited art and the invention. First, the appellant urges that Rowley's computer client is distinct from the end user of the present invention (Appeal Brief, paper 21, page 5, lines 10-12). Second, the appellant urges that the registration profile of Rowley is distinct from the profile of preferences to a user of equipment. (Id., page 5, lines 13-26). Third, the appellant urges that Rowley neither teaches nor suggests the step of determining if an update or a new application is relevant to the end user based on feature and user profiles. (Id., page 6, lines 4-16). Fourth, the appellant urges that Traversat does not teach or suggest notifying the end user, as Traversat's client is a computer, not a user of equipment. (Id., page 6, last three lines).

Prior to addressing the merits of the examiner's rejections, we consider the scope and meaning of certain terms that appear in appealed claim 5. Gechter v. Davidson, 116 F.3d 1454, 1457, 1460 n.3, 43 USPQ2d 1030, 1032, 1035 n.3 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). In proceedings before the U.S. Patent and Trademark Office, unpatented claims must be interpreted by giving words their broadest reasonable meanings in their ordinary usage, taking

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into account the written description found in the specification.

In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

The specification sheds illumination on the term
“preferences” as follows:

Preferences may be explicitly supplied by the end-user in order to be registered at server 120 and/or implicitly derived from, e.g., a user-profile gradually built-up through relations with the hardware and/or service provider. User-preferences relate to, for example, context of use (e.g. profession, hobbies, home, office, hotel, school, college, airport, shopping mall), device characteristics, user needs. (Specification, Page 4, lines 20-24).

It is apparent that the end-user’s “preferences” encompasses more than user-entered data, including simply device characteristics such as a hardware profile. Furthermore, these end user preferences may be device specific, not necessarily user specific, if they are solely built up by hardware relations and reflect only device characteristics, as may be the case as stated in the Specification.

Accordingly, we now turn to the arguments presented for review.

The appellant’s first two arguments are closely related. Appellant first urges that the end user is distinct from the computer, and that Rowley’s registration file, indicating what

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applications are currently installed in the memory of a computer and which need to be updates by a software updating mechanism, cannot be the profile of preferences of the user (Appeal Brief, page 4, line 24 - page 5, last line; Reply brief, page 2, lines 3-7)).

These arguments draw a distinction between the ultimate user of the equipment, a person, and the equipment itself, by asserting that the profile of preferences is particular to a user of the equipment. We agree with this general statement insofar as it applies to the new computing paradigm - shifting value from device-centric to functionality-centric (See, e.g., Specification, page 2, lines 8-11). However, this is an incorrect interpretation of the claim language.

Claim 5 requires storing a profile of the end-user's preferences. Such preferences are broadly defined in the specification as recited above, and may be derived from the hardware alone interacting with the network. Limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993).

Thus, claim, broadly interpreted, is open to a situation where the end user may be a class of persons (e.g. the on-call attendings in a hospital, the duty nurse, etc.) or devices (all nursing PDA's), and not a particular person or device. The

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characteristic profile of preferences may then be derived from the device alone (Rowley's "registration file" at Column 1, line 27) and still fall within the scope of claim 5.

Accordingly, we disagree with the appellant's arguments that the end-user's preferences are particular to one unique user of the equipment and that the end user and end user's preferences cannot be derived from the device itself.

The appellant also urges that Rowley fails to teach if a new application or update is relevant to an end user before presenting it to the end user. (Appeal Brief, page 6, lines 12-19). We disagree. Rowley, column 1, lines 35-39 describes a means for comparing the release file with a registration file to determine which of the installed applications have upgrades available and allowing selection of an upgrade. The selection of relevance is made by comparison to the registration file. Accordingly, we find this argument unpersuasive as well.

The appellant also states that Rowley neither teaches nor suggests notifying the end user via the network of the availability of an option to select a relevant prospective technical feature for addition to the equipment (Appeal Brief, page 6, lines 20-22).

This statement is not entirely accurate. Rowley describes a remote file server having software applications and a release

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file, and a computer memory having a registration file, comparing the registration file to the release file, and having a user interface which allows a user to select at least one application for upgrading. (Column 1, lines 24-50). The notification occurs on the user interface, whose location is not specified as being located remotely on a network. Thus, the examiner's characterization that Rowley discloses a server-client relationship, but not that the end-user is notified of options via a network (Examiner's Answer, page 3, lines 18-19) is accurate. The examiner does not rely on Rowley for this feature, but on the combination of Rowley with Traversat.

The appellant urges that Traversat neither teaches nor suggests notifying the end-user, in that the end-user is a user of equipment and the client of Traversat is a computer. (Appeal Brief, page 6, last paragraph). As we have discussed above, the claims do not require that the end-user be a particular unique individual. Traversat teaches centrally administering the update procedure over a network (column 6, lines 19-31). Specific teaching of update notification is described at column 13, lines 54-65. We therefore disagree that Traversat fails to teach end-user notification over a network.

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Furthermore, we must interpret claims in the broadest reasonable way during examination. Burlington Industries v. Quigg, 822 F.2d 1581, 1583, 3 USPQ2d 1436, 1438 (Fed. Cir. 1987) (claims undergoing examination are given their broadest reasonable construction consistent with the specification); In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) (same).

We therefore affirm this rejection.

Summary of Decision

The rejection of claims 5-9 under 35 U.S.C. §103(a) as being unpatentable over Rowley in view of Traversat, is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

FRED E. McKELVEY)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
SALLY C. MEDLEY)	
Administrative Patent Judge)	APPEALS AND
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